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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,084	11/19/2003	Christopher J. Cookson	3053-066	9419
22440 7590 11/09/2007 GOTTLIEB RACKMAN & REISMAN PC 270 MADISON AVENUE 8TH FLOOR NEW YORK, NY 10016-0601			EXAMINER PSITOS, ARISTOTELIS M	
			ART UNIT 2627	PAPER NUMBER
			MAIL DATE 11/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/718,084

Applicant(s)

COOKSON ET AL.

Examiner

Aristotelis M. Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/2/07 has been entered.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations as defined in claims 1, 17-19,21,22 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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Response to Arguments

Applicant's arguments filed 8/2/07 have been fully considered but they are not persuasive. Again, neither the "bar-code", "symbols", nor the increasing/decreasing limitations are clearly depicted in any of the argued figures.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17-19, 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner cannot readily find support for the newly introduced phrase defining the indicia as recited in dependent claims 17 and 20. Similarly, the limitations with respect to dependent claims 18, 19, 21 and 22.

As far as the claim recite positive limitations, the following art rejections are made.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1,3, 5-8,10,11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murai et al considered with Masuda et al and all further considered with Hioki et al and all further considered with Blankenbeckler et al.

The following analysis is made:

Claim 1

Murai et al

An optical data disc comprising:
a first side and a second side,
each side including at least a first data
layer,
wherein data is arranged on the data layer
of said first side along a first spiral
oriented in a first direction when viewed
on said first side, and data is arranged on the

See abstract, title and description of figs.
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data layer of said second side along a second spiral oriented in a direction opposite that of said first spiral when viewed on said second side, so that a read head that is adjacent to one side can read the data thereon when the disc is rotated in one direction and when adjacent to the other side can read the data thereon when the disc is rotated in the other direction, and

direction indicia disposed on at least one of said first and second sides, said direction indicia being machine readable and being indicative of the direction in which the disc must be rotated to allow data to be read from at least one side, said direction indicia including bar codes.

see secondary references - below

See Blankenbeckler et al

As analyzed above, the Murai et al system disclose an optical record having a first and second side, in which at least one recording layer is contained thereon. The desired "so that" phrase of claim 1 inherently follows.

With respect to the direction indicia – no such information is so contained.

The secondary references to Masuda et al and Hiroki et al discuss the ability in this environment of providing for appropriate "control" indicia – signal/ that indicate which side is "up", or the first side. See the discussion with respect to element 94 in figure 2 and the discussion with respect to figure 3 respectively.

It would have been obvious to modify the base system of Murai et al and modify such with the above noted teachings so as to provide for appropriate "directional indicia" that is "machine readable". Such control information provides for an automatic playback of the media as desired.

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With respect to the newly introduced "bar-code" limitation, applicants' attention is drawn to Blankenbeckler et al who disclose the use of "bar-codes" in this environment for indicating various features – see the description with respect to figure 1 and the insert with respect to elements 116, 117.

It would have been obvious to modify the above noted systems with this additional teaching, motivation is to provide/use existing techniques in order to provide for appropriate information on a record medium.

With respect to claim 7, the phrase "plurality of symbols arranged angularly around the disc", is interpreted as being met by the bar-code teaching of Blankenbeckler et al..

The limitations of claims 1 and 7 are hence met.

With respect to claims 3 and 10, lead in area is provided. Because the indicium in Masuda et al is separate from such, this limitation is met.

With respect to claim 5 this refers to the data found on the record medium. Such data is present in the above references.

With respect to claims 6 and 8, such is met by the above combination of references.

With respect to claim 11, the special section is interpreted as that found in the secondary reference to Masuda et al.

With respect to claim 13 such is present.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

2. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 7 as stated in paragraph 1 above, and further in view of the acknowledge prior art of figure 1.

The limitations of claims 2 and 9 are drawn to the acknowledged prior art multi-layered media known.

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The description of the acknowledged prior art recognizes the claimed limitations.

It would have been obvious to modify the above noted references to include such multiple layers; motivation is as acknowledged – providing increased data storage.

Response to Arguments

The dependent claims fall with their respective parent claim.

3. Claims 4, 12, 14, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 7 as stated in paragraph 1 above, and further in view of the acknowledged prior art, see MPEP section 2144.03 with respect to the previous position regarding Official notice.

With respect to claims 4 and 12, as interpreted, the above combined references provide for the ability of having an appropriate control signal – as recognized by the Hioki et al reference on each side of the record medium. As interpreted above, the special section is interpreted as that of the element 94 in Masuda et al.

As well known in this environment, the use of BCA for appropriate control information is well known and Official notice is taken thereof.

The ability of using such well known techniques – BCA, in the appropriate location – and designate such as a “third” spiral” is considered met by the above combined teachings.

With respect to the limitations of claim 14 such is met when the above references are relied upon.

Response to Arguments

Applicant's arguments filed 11/24/06 have been fully considered but they are not persuasive. The dependent claims fall with their respective parent claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 17 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over O'Hara et al further considered with Blankenbeckler et al.

O'Hara discloses in this environment a dual-sided optical disc which has information recorded thereof in opposite directions – see the discussion with respect to figures 4-6 for instance.

Under 102 considerations, the examiner interprets the address information as disclosed as indicative of a direction – i.e., since the address information increases as it is rotated in the proper direction, the direction is so indicated. The address information is digital – i.e., a plurality of symbols arranged angularly around the disc.

If applicants' can convince the examiner that such is not a correct claim interpretation, then under 103 considerations the examiner further relies upon Blankenbeckler et al for teaching in this environment the use of "bar-codes" as indicative of a plurality of features, see the discussion with respect to figure 1 and the use of bar codes therein.

It would have been obvious to modify the base system O'Hara et al and use bar codes as angularly arranged symbols, motivation is to use existing techniques for indicia.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

5. Claims 18,19,21,and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim17 above, and further in view of modern day compasses.

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As known to those in the arts, modern day compasses have a numerical format that increases in one direction and decreases in the other direction (0 – 360, 360 – 0).

Hence the ability of formatting symbols to increase in one direction and decrease in the other is considered an obvious modification.

Conclusion

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references to Ito et al and Kawamura et al can be relied upon in place of the base reference to Murai et al for disclosing an optical record having the appropriate directional limitations.

The Bartholet et al document is cited as illustrative of an alternative side/directional indicia teaching.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-F: 6:00 - 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aristotelis M Psitos
Primary Examiner
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A handwritten signature in black ink, consisting of a series of loops and a final flourish, positioned to the right of the printed name.

AMP